

REMARKS

Claims 1-40 and 45-78 are pending, with claims 1, 14, 29-31, 36, and 45 being independent. Claims 1, 14, 29-40, 45 and 61 have been amended, and claims 71-78 have been added. Support for the new claims and the amendments to the independent claims may be found in the application at least on page 26, line 1 to page 28, line 11. No new matter has been added.

Applicants wish to thank Examiners Kristie Shingles and Le Luu for the interview conducted on January 12, 2006. During that interview, applicants distinguished the previously pending claims over Hutton (U.S. Patent No. 6,513,066) and Haumont (U.S. Publication No. 2002/0097709). Applicants asserted that Hutton and Haumont both fail to teach that the user of the second client system accepts the request from the user of the first client system. Examiners Shingles and Luu agreed that this distinction had merit and, therefore, conducted a new search that produced the new art cited in the Office Action.

Claims 1-40 and 45-70 have been rejected as being unpatentable over Donovan (U.S. Publication No. 2004/0193722) in view of van Hoff (U.S. Patent No. 5,761,421).

Independent claims 1, 29 and 31, as amended, each recite, among other features, "establishing an instant messaging communications session with the second client to enable instant messaging communications to be exchanged between the first client and the second client over a first communications channel, the first communications channel passing through the communications system host" (emphasis added), "after establishing the instant messaging communications session, sending, through the communications system host, a request to the second client to establish a direct connection to the second client" (emphasis added), and "if a user of the second client accepts the request, establishing, in the instant messaging communications session, a second communications channel between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the second client that bypasses the communications system host" (emphasis added). Applicants request reconsideration and withdrawal of the rejection of claims 1, 29 and 31, and their dependent claims, because neither Donovan, van Hoff, nor any proper combination of the two describes or

suggests establishing an instant messaging communications session to enable instant messaging communications to be exchanged between a first and a second client system over a first communications channel that passes through a communications system host and, after the instant messaging communications session has been established, sending a request to a second client system through the communications system host which, if accepted by a user, establishes, in the same instant messaging communications session, a second communications channel for transferring files that consists of a direct connection to the second client system.

Donovan describes a universal instant messaging system for the Internet. Donovan's system describes a first user (e.g., "Bill") initiating an instant messaging communications session for sending an instant message to a second user (e.g., "Ted") by clicking on the second user's name in a window 50. See paragraph 0033. In response to the first user clicking on the second user's name, an IM manager 34 of the first user sends a message to a SP 18 of the second user (i.e., the instant messaging service provider of the second user) requesting a connection to the IM manager 38 of the first user. See paragraph 0034. In response to receiving the request, the SP 18 may display to the second user a window indicating that the first user is requesting to contact the second user via the IM system and prompting the second user to respond to the request. See paragraph 0034. If the second user accepts the request and a peer-to-peer connection between the PCs of the two users is available, the IM manager 34 sets up a direct peer-to-peer connection between the first user PC and the second user PC over which the two users may directly exchange instant messages and files. See paragraphs 0035-37. If the second user accepts the request and a peer-to-peer connection between the PCs of the two users is not available, a relay connection is established between SP 14 of the first user and SP 18 of the second user over which the two users may exchange instant messages and files. See paragraphs 0035-37.

Notably, Donovan describes the acceptance of the request by the second user as a prerequisite for establishing an instant messaging communications session for enabling instant messages to be exchanged between the users. Once the request has been accepted, the instant messaging communications session is initiated and no further connection requests are exchanged between the users in the instant messaging communications session. Accordingly, Donovan does

not describe or suggest establishing an instant messaging communications session to enable instant messaging communications to be exchanged between a first and a second client system over a first communications channel that passes through a communications system host and, after the instant messaging communications session has been established, sending a request to a second client system through the communications system host which, if accepted by a user, establishes, in the same instant messaging communications session, a second communications channel for transferring files that consists of a direct connection to the second client system.

Van Hoff describes a system and method for establishing a peer-to-peer communication connection between computer programs from the same security domain. Van Hoff does not remedy the failure of Donovan to describe or suggest the above-recited features.

For at least these reasons, applicants request reconsideration and withdrawal of the rejection of claims 1, 29 and 31, and their dependent claims 2-13, 32-35, 53, 55, 57, 59, 61, 63, 65, 67 and 69.

Independent claims 14, 30 and 36, as amended, each recite, among other features, “establishing an instant messaging communications session with the first client to enable instant messaging communications to be exchanged between the first client and the second client over a first communications channel, the first communications channel passing through the communications system host” (emphasis added), “after establishing the instant messaging communications session, receiving, through the communications system host, a request to the second client to establish a direct connection to the second client” (emphasis added), and “establishing, in the instant messaging communications session, a second communications channel between the first client and the second client to enable files to be directly transferred between the first client and the second client, wherein the second communications channel consists of a direct connection to the first client that bypasses the communications system host” (emphasis added). For at least the reasons described above, applicants request reconsideration and withdrawal of the rejection of claims 14, 30 and 36, and their dependent claims 15-28, 37-40, 54, 56, 58, 60, 62, 64, 66, 68 and 70, because neither Donovan, van Hoff, nor any proper combination of the two describes or suggests the recited features.

Applicant : James Crawford
Serial No. : 09/597,784
Filed : June 19, 2000
Page : 18 of 18

Attorney's Docket No.: 06975-
097001 / Communications 21

Independent claim 45, as amended, recites, "a first graphical user interface element structured and arranged to notify an operator of the second client of a request by the first client to establish a direct connection to the second client, the request being communicated to the second client by a communications system host after establishment of an instant messaging communications session with the first client and the direct connection bypassing the communications system host, the instant messaging communications session enabling instant messaging communications to be exchanged between the first client and the second client over a first communications channel that passes through the communications system host; and a second graphical user interface element structured and arranged to enable an operator of the second client to authorize the establishment of the direct connection and a file transfer over the direct connection in the instant messaging communications session" (emphasis added). For at least the reasons described above, applicants request reconsideration and withdrawal of the rejection of claim 45 and its dependent claims 46-52 because neither Donovan, van Hoff, nor any proper combination of the two describes or suggests the recited features.

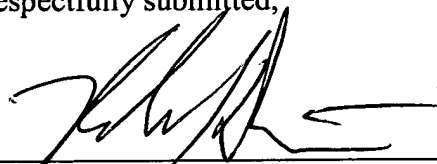
Applicants submit that all claims are in condition for allowance.

Enclosed is a \$400 check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Date: _____

4/24/06

Respectfully submitted,



Roberto J. Devoto
Reg. No. 55,108

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331